

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

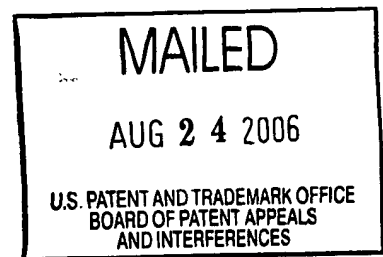
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JEFFREY BURNS, HILARIOS S. COSTA and ROBERT W. RIGHT

Appeal No. 2006-1182
Application No. 09/961,104

ON BRIEF



Before HAIRSTON, JERRY SMITH and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-23.

The disclosed invention pertains to an alarm pull-station with camera.

Representative claims 1 and 20 are reproduced as follows:

1. A manually operated pull-station for activating an alarm system, the pull-station comprising:

housing;

a manually actuated lever movable between armed and activated positions; and

a camera configured to be mounted a distance away from said lever such that blind areas are substantially constrained.

20. A method of handling data in a pull station for activating an alarm system comprising the steps of:

capturing image data in the vicinity of the pull station with a camera, wherein said camera is configured to be positioned within a housing such that a field a view of said camera is not obstructed and substantially limits blind areas; and

recording the captured image data.

The examiner relies on the following references:

Apgar	3,877,005	Apr. 8, 1975
McCall et al. (McCall)	6,002,430	Dec. 14, 1999
Zellner et al. (Zellner)	US 2004/0088345	May 6, 2004
(Effective filing date: Jun. 2, 2000)		

The following rejections are on appeal before us:

2. Claims 1-4 and 17-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Apgar.
4. Claims 5, 6, 14-16, 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Apgar.
6. Claims 7-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Apgar in view of Zellner.
8. Claims 1-6, 14 and 16-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Apgar in view of McCall.
10. Claims 7-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Apgar in

12. in view of McCall, and further in view of Zellner.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii)(2004). See also In re Watts, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

It is our view, after consideration of the record before us, that the evidence relied upon by the examiner does support the examiner's rejections of claims 1-23. Accordingly, we affirm. I. We consider first the examiner's rejection of claims 1-4 and 17-19 as being anticipated by Apgar.

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. Perricone v. Medicis Pharmaceutical Corp., 432 F.3d 1368, 1375-6, 77 USPQ2d 1321, 1325-6 (Fed. Cir. 2005), citing Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992). To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (internal citations omitted). "Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (internal citations omitted).

Appellants argue that the instant invention is patentable over the cited prior art references because the camera is positioned within the alarm housing such that blinds spots are substantially limited or constrained [brief, page 8, emphasis

added]. Appellants further argue that the instant camera is mounted in the housing a sufficient distance from the lever to prevent the camera's field of view from being obstructed when the pull-station is activated [brief, page 8]. Appellants note that a distinct advantage of mounting the camera so that the lens is a distance from the lever is that it prevents an individual from activating the lever and, while doing so, circumventing the camera's field of view [answer, page 8]. Appellants point out that both independent claims 1 and 17 recite this distinct feature [*id.*].

In response, the examiner notes that Apgar teaches a camera 28 mounted above a manually actuated handle 24 of a fire alarm pull station [answer, page 10]. The examiner points out that fig. 2 of Apgar shows that camera 28 is mounted a sufficient distance above handle 24 so as to photograph a person who activates the alarm [*id.*]. The examiner argues that pulling alarm handle 24 would not obstruct the field of view of Apgar's camera because the camera is located a sufficient distance above the alarm pull handle [answer, page 6].

We note that independent claim 1 merely requires "a camera configured to be mounted a distance away from said lever such that blind areas are substantially constrained" [claim 1, emphasis added]. Similarly, independent claim 17 merely requires "said means for capturing is positioned a distance away from said means for actuality such that a field a view of said means for

capturing is not obstructed and substantially limits blind areas" [claim 17].

We note that our reviewing court has adopted a broad construction for the term "substantial" as used in patent claims. The Court of Appeals for the Federal Circuit has recently reaffirmed that the term "substantial" implies "approximate." Wilson Sporting Goods Co. v. Hillerich & Bradsby Co., 442 F.3d 1322, 1329, 78 USPQ2d 1382, 1387 (Fed. Cir. 2006). See also Playtext Products, Inc. v. Procter & Gamble Co., 400 F.3d 901, 907, 73 USPQ2d 2010, 2015 (Fed. Cir. 2005) ("The term 'substantial' is a meaningful modifier implying 'approximate,' rather than 'perfect.' "), citing Liquid Dynamics Corp. v. Vaughan Co., Inc., 355 F.3d 1361, 1368, 69 USPQ2d 1595, 1600 (Fed. Cir. 2004). In Wilson Sporting Goods, the court determined that a claimed "insert having a substantially circular cross-section" did not need to be perfectly circular [emphasis added]. Wilson Sporting Goods, 442 F.3d at 1328-29, 78 USPQ2d at 1387. Similarly, in Playtext Products, the court determined that the claimed "substantially flattened surfaces" did not require a perfectly flat surface [emphasis added]. Playtext Products, 400 F.3d at 907, 73 USPQ2d at 2015.

Given the broad construction accorded the term "substantial" by the Court of Appeals for the Federal Circuit, we find that the orientation and field of view of Apgar's camera 28, as shown in

fig. 2, clearly meets the language of the instant independent claims. In particular, we note that the field of view of camera 28 is explicitly shown in fig. 2 as being substantially above handle 24 that is pulled outward and downward to activate the fire alarm. We find that handle 24 cannot possibly obstruct the field of view of camera 28 when the alarm is activated because handle 24 pivots at pivot 26 when pulled outward, thus pulling the handle downward and further away from the field of view of camera 28 [Apgar, fig. 2]. We recognize that Apgar's embodiment shown in fig. 2 does not preclude the possibility that a person could activate the fire alarm from the side and thereby remain outside the camera's field of view [Apgar, fig. 2]. However, we find that a proper construction of the term "substantially," as recited in each independent claim, does not require a perfect elimination of all blind areas [emphasis added]. In contrast, we find that the distance between Apgar's camera 28 and handle 24 is clearly sufficient to meet the language of the independent claims that merely requires the blind areas be substantially (i.e., approximately) limited or constrained [Apgar, fig.2, emphasis added]. Accordingly, we will sustain the examiner's rejection of independent claims 1 and 17 as being anticipated by Apgar.

We note that appellants argue that dependent claims 2-4, 18 and 19 are also patentable over the prior art of record because these claims each include features of the respective independent claims from which they depend [brief, page 8].

Accordingly, because we have sustained the examiner's rejection of independent claims 1 and 17 as being anticipated by Apgar, we will also sustain the examiner's rejection of claims 2-4, 18 and 19 for the same reasons discussed *supra* with respect to claims 1 and 17.

II. We next consider the examiner's rejection of claims 5, 6, 14-16, 20 and 21 as being unpatentable over the teachings of Apgar [answer, page 5].

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472,

223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

With respect to independent claim 20, we note that appellants argue that the language of the claim requires a camera that is mounted a distance away from the lever to eliminate blind spots [brief, page 9, ¶3, emphasis added]. In response, we note that a proper construction of the term "substantially" does not require a perfect elimination of all blind areas, as discussed *supra* [emphasis added]. In particular, we note that the total elimination of all blind areas is not claimed [emphasis added]. Patentability is based upon the claims. "It is the claims that measure the invention." SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (*en banc*). When making a patentability determination, the claimed invention must be compared to the prior art [*id.*, emphasis added]. We find that the Apgar reference clearly meets the recited language that merely requires the camera's field of view not be obstructed and also that blind areas be substantially (i.e., approximately) limited [emphasis added]. Accordingly, we will sustain the examiner's rejection of independent claim 20 as being obvious over Apgar.

We note that appellants argue that dependent claims 5, 6, 14-16 and 21 are also patentable over the prior art of record because these claims each include features of the respective independent claims from which they depend [brief, pages 8 and 9]. We note

that we have sustained the examiner's rejection of independent claims 1 and 17 as being anticipated by Apgar, and we have also sustained the examiner's rejection of independent claim 20 as being obvious over Apgar, *supra*. Accordingly, we will also sustain the examiner's rejection of claims 5, 6, 14-16 and 21 for the same reasons discussed *supra* with respect to claims 1, 17 and 20.

III. We next consider the examiner's rejection of claims 7-13 as being unpatentable over the teachings of Apgar in view of Zellner [answer, page 6].

We note that appellants do not specifically address the Zellner reference in the brief. Instead, appellants argue that dependent claims 7-13 are patentable over the prior art of record because these claims each include features of independent claim 1 from which they depend [brief, page 8]. Accordingly, because we have sustained the examiner's rejection of independent claim 1 as being anticipated by Apgar, we will also sustain the examiner's rejection of claims 7-13 for the same reasons discussed *supra* with respect to claim 1.

IV. We next consider the examiner's rejection of claims 1-6, 14 and 16-23 as being unpatentable over the teachings of Apgar in view of McCall [answer, page 8].

Appellants assert that McCall merely discloses a camera having an expansive field of view and does not teach nor suggest a camera in combination with an alarm system [brief, page 9]. Appellants

argue that McCall fails to teach or suggest a camera configured to be mounted a distance away from the lever (i.e., pull handle) such that blind areas are substantially constrained, as claimed [*id.*]. Finally, appellants argue the examiner is using hindsight reconstruction to pick and choose among isolated disclosures in the prior art to duplicate the claimed invention [*id.*].

In response, the examiner notes that the McCall reference was used to show that it was known in the art for a camera to use a wide-angle lens for capturing a 180-degree field of view [answer, page 11; see also McCall at col. 4, line 35 and col. 5, lines 1-5 and 22-26]. The examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the camera taught by Apgar to include a lens with a wide viewing angle if a 180-degree field of view was deemed necessary to cover the area being monitored [*id.*].

In response to Appellants' argument that McCall does not teach nor suggest a camera in combination with an alarm system [brief, page 9], we note that the Court of Appeals for the Federal Circuit has determined that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, the examiner's rejection is based upon the combination of the Apgar and McCall references [emphasis added]. We note that Apgar explicitly teaches a camera in combination with an alarm system

(as shown in fig. 2), and also that McCall explicitly teaches a camera with a 180-degree field of view [col. 5, lines 1-6].

Appellants restate the argument that the language of the claim requires a camera that is mounted a distance away from the lever to eliminate blind spots [brief, page 9, ¶3, emphasis added].

In response, we note that the total elimination of blind spots is not claimed and also that a proper construction of the term "substantially" does not require a perfect elimination of all blind areas, as discussed *supra* [emphasis added]. We note that the language of independent claims 1, 17 and 20 merely requires the mounting or positioning of the camera a distance away from the lever (or means for actuating the alarm system) such that the camera's field of view is not obstructed and also that blind areas are substantially (i.e., approximately) limited [emphasis added]. We find that this language is clearly met by the Apgar reference.

With respect to appellants allegation that the examiner has impermissibly applied hindsight reasoning, we note that to reach a proper conclusion under §103, the examiner, as finder of fact, must step backward in time and into the mind of a person of ordinary skill in the art at a time when the invention was unknown, and just before it was made. In light of all the evidence, we review the specific factual determinations of the examiner to ascertain whether the examiner has convincingly established that the claimed invention as a whole would have been

obvious at the time of the invention to a person of ordinary skill in the art.

In the instant case, the examiner proffers that an artisan having knowledge of both the Apgar and McCall references would have recognized that a camera with a wider field of view would be ideal in preventing false alarms by capturing a photograph of the person actuating the alarm [answer, page 11]. The examiner further asserts that this wider field of view would provide an image of the person regardless of the position of the person with respect to the camera [*id.*].

The Court of Appeals for the Federal Circuit has determined that the motivation to combine under §103 must come from a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor [emphasis added]. Ruiz v. A.B. Chance Co., 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000). After carefully reviewing all the evidence before us, we find that the examiner has provided a convincing line of reasoning that flows directly from nature of the problem to be solved and is also well within the general knowledge of a person of ordinary skill [emphasis added].

We note that Apgar teaches a camera that captures an image of the person who activates the alarm. As discussed *supra*, we note that

Apgar's system could possibly be defeated if the person triggering the alarm pulled the handle from a side of the alarm that may be outside of the camera's frontal field of view. We agree with the examiner that an artisan having knowledge of both the Apgar and McCall references would have recognized that a camera with a wider field of view would be ideal in preventing false alarms by capturing a photograph of the person actuating the alarm [answer, pages 9 and 11]. Therefore, we do not agree with appellants that the examiner has impermissibly applied hindsight in formulating the rejection. Accordingly, we will sustain the examiner's rejection of independent claims 1, 17 and 20 as being obvious over Apgar in view of McCall for essentially the same reasons argued by the examiner.

We note that appellants argue that dependent claims 2-6, 14, 16, 18, 19 and 21-23 are patentable over the prior art of record because these claims each include features of the respective independent claims from which they depend [brief, pages 8 and 9]. Accordingly, because we have sustained the examiner's rejection of independent claims 1, 17 and 20 as being obvious over Apgar in view of McCall, we will also sustain the examiner's rejection of claims 2-6, 14, 16, 18, 19 and 21-23 for the same reasons discussed *supra* with respect to claims 1, 17 and 20.

V. Lastly, we consider the examiner's rejection of claims 7-13 as being unpatentable over the teachings of Apgar in view of McCall, and further in view of Zellner [answer, page 9].

Appellants note that dependent claims 7-13 ultimately depend upon independent claim 1 [brief, page 10]. Appellants argue that claims 7-13 are patentable for the same reasons previously discussed with respect to independent claim 1 that stands rejected as being unpatentable over the teachings of Apgar in view of McCall [*id.*].

We note that appellants do not specifically address the Zellner reference in the brief. Accordingly, because we have sustained the examiner's rejection of independent claim 1 (and dependent claim 3 from which claim 7 depends), as being obvious over Apgar in view of McCall, we will also sustain the examiner's rejection of claims 7-13 as being obvious over the teachings of Apgar in view of McCall, and further in view of Zellner.

In summary, we have sustained the examiner's rejections of all claims on appeal. Therefore, the decision of the examiner rejecting claims 1-23 is affirmed.


Appeal No. 2006-1182
Application No. 09/961,104

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED.


KENNETH W. HAIRSTON
Administrative Patent Judge

Jerry Smith
JERRY SMITH
Administrative Patent Judge


HOWARD B. BLANKENSHIP
Administrative Patent Judge

BOARD OF PATENT
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